

Appl. No. 09/548,946
Amdt. dated September 7, 2004
Reply to Office Action of June 8, 2004

PATENT

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on June 8, 2004.

Entry of this Amendment is requested.

In this Amendment, claims 5-9 and 13 are canceled, claim 10 is amended, and claims 15-18 are added so that claims 10-12 and 14-18 are pending and subject to examination.

At page 2 of the Office Action, claim 13 is rejected under 35 USC 112, first paragraph. According to the Examiner, the description in the specification does not include a leadframe including apertures.

In response thereto, the paragraph at page 4, line 9 of the specification has been amended to provide a description of the elongated apertures in the leadframe 11 shown in Figure 4. The addition of this description does not constitute new matter as the apertures are clearly shown in Figure 4. As indicated by the Court of Appeals for the Federal Circuit, "Under proper circumstances, drawings may provide a written description of an invention as required by 35 U.S.C. 112. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991). Withdrawal of the rejection is requested.

Claims 5, 6, 8, and 9 are rejected as obvious over Williams et al. (US 6307755) and Temple et al. (US 5103290). Claim 7 is rejected as obvious over Williams et al., Temple et al. and Kalfus et al. (US 4935803).

Claims 5-9 have been canceled so that these rejections are moot.

Claims 10-12 and 14 are rejected as obvious over Williams et al., Temple et al., and Kalfus et al.

The limitation in dependent claim 13 has been incorporated into independent claim 10. Accordingly, the rejection of claims 10-12, and 14 should be moot.

Claim 13 is rejected as obvious over Williams et al., Temple et al., Kalfus et al., and Ewer. This rejection is traversed.

Obviousness has not been established, since all claim limitations are not taught or suggested by the cited references. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981,

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180 USPQ 580 (CCPA 1974). The Examiner acknowledges that neither Williams et al., Temple et al., nor Kalfus et al. teach apertures in a leadframe. Ewer is cited for its alleged teaching of apertures in a leadframe substrate. The Examiner refers to the apertures being associated with the elements corresponding to reference numbers 13 and 14 in Ewer. However, the apertures in elements 13 and 14 are clearly not under a bumped die. Accordingly, since all claim limitations are not taught or suggested by the cited references, obviousness has not been established.

Applicants also submit that any proposed obviousness rejection relying on at least four separate references picking and choosing from isolated disclosures from those four references would necessarily be based on improper hindsight. As set forth in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided **only** by the prior art references and the then-accepted wisdom in the field. ... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which **only** the invention taught is used against its teacher."

...
Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. ... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. ... Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

Also, one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). In order to arrive at the inventions of the pending claims, the Examiner must pick and choose from isolated disclosures in no less than four references with very different structures and very different objectives. Applicants submit that one viewing

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"only" the four cited references, *without* viewing Applicants' patent application first, would not have picked and chosen isolated teachings in these four references as in the Office Action. Accordingly, Applicants submit that the combination of references was based on improper hindsight and withdrawal of the obviousness rejection is requested.

CONCLUSION

Applicants submit that there are many more reasons why one would conclude that embodiments of the invention are not obvious, rather than obvious. Accordingly, in view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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